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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 8997**
Peter HEROLD et al. : Attorney Docket No. 2006_1381A
Serial No. 10/593,461 : Group Art Unit 1626
Filed September 19, 2006 : Examiner Rei Tsang Shiao
ORGANIC COMPOUNDS : Mail Stop: AF

**RESPONSE UNDER 37.CFR.116
EXPEDITED PROCEDURE
EXAMINING GROUP-----1000**

REQUEST TO WITHDRAW FINALITY OF REJECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEE FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975.

Sir:

The Office Action mailed June 29, 2009 includes, in item 7 on page 4, a rejection of claims 1-7 and 9-12 under the second paragraph of 35 U.S.C. §112, based on the expression "which on in vivo application ... non-radioactive isotopes". This same expression was present in claim 1 as initially acted upon by the Examiner in issuing the earlier Office Action of December 3, 2008. However, the Examiner did not at that time make any rejection under 35 U.S.C. §112 based on this expression.

According to MPEP 706.07(a):

"Under present practice, second or any subsequent actions on the merits shall be final, **except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims**, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." (emphasis added)

Since the rejection of the claims under the second paragraph of 35 U.S.C. §112 set forth in the current Office Action was not necessitated by Applicants' amendment of the claims, the current Office Action should not have been final.

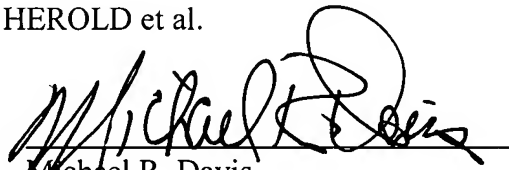
Therefore, Applicants request that the finality of the current Office Action be withdrawn, and that this be communicated in writing to Applicants' attorney.

The Commissioner is authorized to charge any deficiency or to credit any overpayment associated with this communication to Deposit Account No. 23-0975, with the EXCEPTION of deficiencies in fees for multiple dependent claims in new applications.

Respectfully submitted,

Peter HEROLD et al.

By:

A handwritten signature in black ink, appearing to read "Michael R. Davis", written over a horizontal line.

Michael R. Davis

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July 13, 2009